

REMARKS

In the Office Action,¹ the Examiner rejected claims 1-19 and 24-30 under 35 U.S.C. § 101 as being purportedly directed to non-statutory subject matter; and rejected claims 1-34 under 35 U.S.C. § 103(a) as being purportedly unpatentable over International Publication No. WO 01/018674 to Maloney et al. ("*Maloney*") in view of U.S. Publication No. 2002/0059030 to Otworth et al. ("*Otworth*").

By this Amendment, Applicants cancel claims 25-34 without prejudice or disclaimer. Therefore, the rejections of claims 25-34 are rendered moot.

Rejection of Claims 1-19 and 24 Under 35 U.S.C. § 101

Applicants respectfully traverse the rejection of claims 1-19 and 24 under 35 U.S.C. § 101 as being purportedly directed to non-statutory subject matter. However, to advance prosecution, Applicants amend independent claims 1, 11, and 24 to incorporate the subject matter of dependent claims 31, 32, and 33, respectively, which were not rejected under 35 U.S.C. § 101. Claims 1-19 and 24 recite statutory subject matter at least because these claims include "a computer-readable storage medium." Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 1-19 and 24 under 35 U.S.C. § 101.

¹ The Office Action contains a number of statements reflecting characterizations of the related art, case law, and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

Rejection of Claims 1-24 Under 35 U.S.C. § 103(a)

Applicants respectfully traverse the rejection of claims 1-24 under 35 U.S.C. § 103(a) as being purportedly unpatentable over *Maloney* in view of *Otworth*, because a *prima facie* case of obviousness has not been established.

“The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious.” M.P.E.P. § 2142(III), 8th Ed., Rev. 6 (Sept. 2007). “[T]he framework for objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). . . . The factual inquiries . . . are as follows:

(A) [Determining the scope and content of the prior art;]

(B) Ascertaining the differences between the claimed invention and the prior art;
and

(C) Resolving the level of ordinary skill in the pertinent art.”

M.P.E.P. § 2141(II). “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III).

Independent claim 1 recites, among other things, “based on the received answers, selecting from a plurality of testing materials, at least one customized set of testing material.”

Applicants have previously established that *Maloney* fails to teach or suggest selecting at least one customized set of testing material “based on the received answers,” as recited in claim 1. See Request for Reconsideration, filed on July 5, 2007, pp. 4-5. In response, the Examiner attempts to cure the deficiencies of *Maloney* with

Otworth, alleging that “*Otworth et al* teaches a method and system . . . and includes: based upon collected historical data related to a subject, providing the subject with a customized kit.” Office Action at 6. However, even assuming the Examiner’s characterization of *Otworth* is correct, which Applicants do not concede, *Otworth* still fails to cure the deficiencies of *Maloney*.

Otworth discloses “establishing . . . tests . . . based upon historical data related to the subject.” *Otworth*, para. [0043]. *Otworth* further discloses “a review of a history of the subject to determine which test should be administered.” *Id.*, para. [0168]. *Otworth* provides “blood sugar levels,” (para. [0161]), “high blood pressure,” (para. [0168]), etc., as examples of historical data on the subject. However, *Otworth* does not teach or suggest that the historical data related to the subject include “answers to [a] set of personal questions,” as recited in claim 1, or that the historical data related to the subject are obtained through “asking the subject the set of personal questions” and “receiving answers to the set of personal questions,” as recited in claim 1. Instead, *Otworth* discloses that historical data on the subject are obtained by querying a data service 200. See *id.*, para. [0168] and Fig. 7.

Therefore, even if *Otworth* were to disclose determining a test kit based on historical data related to the subject, *Otworth* does not disclose determining a test kit “based on the received answers,” as recited in claim 1 (emphasis added), because *Otworth* does not teach or suggest that the historical data related to the subject include received answers. For at least the foregoing reasons, *Otworth* fails to teach or suggest “based on the received answers, selecting from a plurality of testing materials, at least

one customized set of testing material,” as recited in claim 1. Accordingly, *Otworth* fails to cure the deficiencies of *Maloney*.

Because *Maloney* and *Otworth*, individually or in combination, fail to teach or suggest all the features of claim 1, the Examiner has not properly ascertained the differences between the prior art and claim 1. Accordingly, the Examiner has failed to clearly articulate a reason why the prior art would have rendered claim 1 allegedly obvious to one of ordinary skill in the art. Therefore, a *prima facie* case of obviousness has not been established with respect to claim 1.

In addition, independent claims 11, 20, and 24, although different in scope from claim 1, include recitations having at least some similarity to the above-quoted recitations of claim 1. For example, each of claims 11, 20, and 24, recites “based on the received answers, selecting . . . at least one customized set of testing material.” *Maloney* and *Otworth* fail to teach these features of claims 11, 20, and 24 for at least reasons similar to those given above with respect to claim 1. Also, dependent claims 2-10, 12-19, and 21-23 are allowable at least by virtue of their dependence from allowable base claims 1, 11, and 20. Therefore, a *prima facie* case of obviousness has not been established with respect to claims 1-24. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 1-24 under 35 U.S.C. § 103(a).

Conclusion

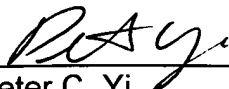
Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

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By: 
Peter C. Yi.
Reg. No. 61,790
202.408.4485